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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/824,035

04/03/2001

Nobuyuki Tanaka

WN-2316

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06/30/2006

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EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,035

Applicant(s)

TANAKA, NOBUYUKI

Examiner

Hai Tran

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11, 13, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 04/05/2006 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the prior art rejections have been considered but are moot in view of the new ground(s) of rejection.

Regarding to the 35 U.S.C. § 101 rejection, the Examiner maintains the rejection because amended claim 16 merely recites "a computer data signal" which claims nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, per se, and as such are nonstatutory natural phenomena. O'reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.(see USPTO OG Notices: 22 November 2005; Annex IV (c) Electro-Magnetic Signals @ <http://www.uspto.gov/web/offices/com/sol/oq/2005/week47/patgupa.htm>).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 is rejected under 35 U.S.C. 101 the claimed invention is directed to non-statutory subject matter.

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Claim 16 merely recites "a computer data signal" which claims nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, per se, and as such are nonstatutory natural phenomena. O'reilly, 56 U.S. (15 How.) at 112-14.

Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

Applicant is advised to follow USPTO OG Notices: 22 November 2005; Annex IV (c) Electro-Magnetic Signals @

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-10, 12, and 14-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added limitations in claim 1-2, 12, 14-17, and 22 contain subject matter which was not described in the specification for example, claims 1, 12 and 22

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with limitation " audio-visual input switching device receiving only one of a video signal and an audio signal from one of said reproducing device and said backup reproducing device"; Claims 14-15 with limitation "supplying only one of a video signal and an audio signal to an audio-visual input switching device to reproduce the movie, when the predetermined signal is not sent from the reproducing device."; and Claims 16-17 with limitation "supplying, by the backup reproducing device, only one of a video signal and an audio signal to an audio-visual input switching device to reproduce the movie, when the predetermined signal is not sent from the reproducing device."

None one the amended limitations in claim 1-2, 12, 14-17, and 22 where found in the Applicant's specification. Applicant 's specification clearly shows that both video and audio signal from either reproducing device to the AV switching device (see Fig. 7, step A4 and A7; specification page 10) and NOT only one of a video signal and an audio signal (only one video signal or only one audio signal) from one of said reproducing device and said backup reproducing device (either one of the reproducing devices).

2. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 16, It is unclear how a computer data signal could be stored in a media, as claimed. The Examiner believes claim 16 corresponds to Applicant 6<sup>th</sup> aspect of the invention (page 4 of the Specification) in which the claimed "a media" is clearly "a carrier wave" in which one of ordinary skill in the art would not understand how a computer data signal is stored in a carrier wave.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 17, the phrase "being adaptable" renders the claim indefinite because the intended scope of the claim was unclear. See MPEP § 2173.05(d).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

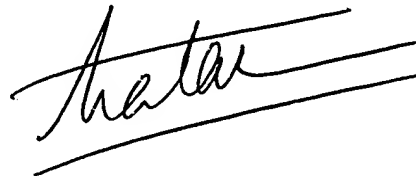
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht  
06/22/2006

A handwritten signature in black ink, appearing to read 'HAITRAN', is written over two horizontal lines.

**HAITRAN  
PRIMARY EXAMINER**